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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,733	05/01/2002	Jean-Jacques Braconnier	022701-978	6028

21839 7590 08/24/2005

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ALEXANDRIA, VA 22313-1404

EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,733

Applicant(s)

BRACONNIER, JEAN-JACQUES

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 & 31 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14,16,17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,11-14,16,17,19 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 6-10 and 20-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05/11/2005.
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 08/20/2005.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-2, 4-14, 16-17, and 19-29 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2005 has been entered.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims having the acids now set forth in the independent claims is withdrawn in view of the reference to Nippon Steel Corporation, EP 0 902 103 A1. Said reference is of record and was cited on the Form PTO-892 dated July 25, 2003. Rejections based on the newly cited reference(s) follow. The examiner regrets any inconvenience to applicants and their representatives.

#### ***Information Disclosure Statement***

3. The information disclosure statement filed May 11, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. While applicants provide the JPO Abstract, a copy of the reference has not been provided.

Art Unit: 1712

The examiner has considered the JPO abstracts and cited the abstracts and has made them of record on the Form PTO-892 for applicants' convenience.

***Claim Objections***

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The "said acids" denoted in the independent claim 1 all have "a pKa of at least 3". Therefore, claim 2 cannot be further limiting since the pKa values are inherent to the species of claim 1.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4-511-14, 16-17, 19, and 25-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nippon Steel Corporation, EP 0 902 103 A1 (hereafter Nippon Steel). Nippon Steel (abstract;

Art Unit: 1712

paragraph [0007] et seq, particularly paragraphs [0036] et seq ; paragraph [0048] ; and Tables 1 and 2 ; examples 8 and 34) discloses surface treatment compositions, which (fig. 1; and paragraph [0048]) take the form of colloids or a solution form with low solid dispersion depending on the relative amount of the diluting agent. Nippon Steel (Table 1 and 2; examples 8 and 34) discloses combinations of lanthanum oxide, phosphoric acid, and cerium acetate or combinations of cerium phosphate, phosphoric acid, and cerium acetate. Nippon Steel (Fig. 1; and paragraph [0015]) discloses the formation of lanthanum orthophosphate particles. Nippon Steel clearly contemplates and discloses colloidal particle dispersions or low solid dispersions, which read on the claimed characterization of the compositions as sols.

Nippon Steel (paragraph [0049]) discloses the formation of films having a thickness of 0.1 to 1 micron. 0.1 micron equates to 100 nm. Thus, it is reasonable to conclude the particles in said dispersions would have a particle size of 100 nm or less to form said films. The claimed particle size of claims 5, 17, 19, and 28 would have been expected to be inherent to the compositions that are otherwise anticipated and Nippon Steel discloses films thicknesses consistent with said particle sizes.

Claims directed to polishing, anti-corrosion and an anti-UV agent are either anticipated or at least obvious since the intended use has been given little patentable weight for the defined compositions. Said compositions would have been expected to have been capable of use in each of the claimed utilities, i.e., polishing, anti-corrosion and an anti-UV agents.

Art Unit: 1712

Regarding the pH, Nippon Steel discloses the equilibrium formation of hydroxides and multiple buffering species, e.g.,  $\text{HPO}_4^-$ , acetate. The Nippon Steel reference clearly contemplates a range of pH values. Furthermore, Nippon Steel is directed to corrosion inhibitors, which would necessitate a mild pH rather than an aggressive pH of 4 or below, common of etching solutions.

To the extent the claims differ in an exemplified colloid form and/or an exemplified particle size, Nippon Steel discloses variation of the relative amount of the dilution would result in varying particle dispersions as paste, colloidal and low solids dispersions. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to vary the relative dilution for the advantage of the desired film formation and thickness (see Fig.1). Some variation in the particle size would have been expected and has not been shown to be critical to applicant's invention.

#### ***Allowable Subject Matter***

8. Claims 6-10 and 20-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-2, 4-5, 11-14, 16-17, 19, and 25-29 have been considered but are moot in view of the new ground(s) of rejection.

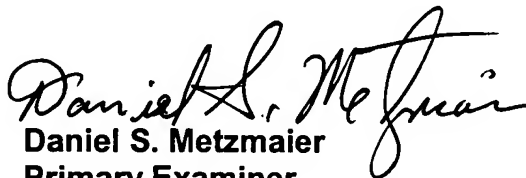
10. The rejection under 35 US 112, first paragraph, of claim 29 has been withdrawn in view of applicant's remarks.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM